

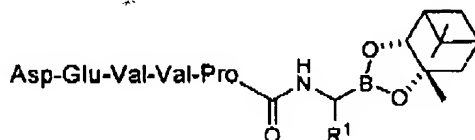
## Remarks

**Status of the claims.** Claims 16-20 are pending. Claims 1-15 were previously cancelled. Claims 18 and 20 have been withdrawn from consideration. Claim 19 was rejected under 35 USC 112, first paragraph. Claims 16 and 17 were rejected under 35 USC 112, second paragraph. Claims 16, 17, and 20 were rejected under 35 USC 102 and 103.

**Amendments to the claims.** In addition to the amendments explained below, claims 17-20 were amended to correctly depend on claim 16.

**Rejection based on 35 USC 112, first paragraph.** Claim 19 was rejected for not enabling the term "pharmaceutical." The term "pharmaceutical" has been deleted.

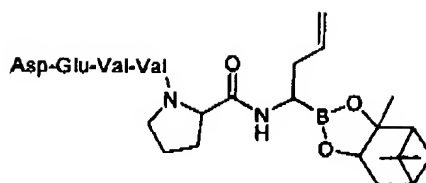
**Rejection based on 35 USC 112, second paragraph.** The generic structure of claim 16 was deemed indefinite and the examiner suggested amending the structure to incorporate claim limitations. The applicants adopted the examiner's suggestion and presented a generic structure which incorporated the claim limitations and added clarity (shown below).



Claim 17 was deemed indefinite as to a species which read "...3-(1,1'-biphenyl)-4-ylpropylboronic..." The species name was amended to "...3-(1,1'-biphen-4-yl)propylboronic..." to correctly identify the species.

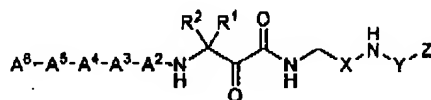
**Rejection based on 35 USC 102.** The examiner stated that both Han et al., US patent 6,774,212 and Zhang et al., US patent 6,699,855 taught the core pentapeptide (disclosed as sequence ID no. 11) in a composition with boronic acid and pinanediol ester and phenylpropyl. Based on this, the examiner rejected claims 16, 17, and 20 under 35 USC 102(e). The applicants respectfully traverse.

In order to anticipate, a reference must teach every element of the claim. The pentapeptide Asp-Glu-Val-Val-Pro-boroAlg-pinanediol ester (SEQ ID NO. 11, shown below) contains a C-terminus amino acid moiety (or in this case, a B-terminus) with an allyl side chain (for definition of Alg, see Green column 35, line 36). Thus, this species does not fall within the scope of the claimed genus.

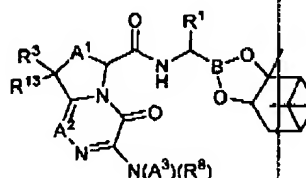


SEQ. ID NO. 11: H-Asp-Glu-Val-Val-Pro-boroAlg-pinandediol ester

Additionally, the pentapeptide is not an embodiment of either Han or Zhang's Markush structures (shown below). Instead, this single pentapeptide is used as a standard reference reagent in an assay to determine protease concentration. The Han Markush structure defines a series of compounds which all contain a diketamide moiety. The Zhang Markush structure defines a series of bicyclic heterocycles. Therefore, to apply variables, such as phenylpropyl, from the Han and Zhang Markush structures to the single pentapeptide is inappropriate.



### Han subgenus



### Zhang subgenus

Because no species falls within the claimed genus and because neither the Han nor the Zhang genus properly confers a variable to the pentapeptide for the purpose of anticipation, the applicants believe the references do not anticipate the claimed compounds and respectfully request the examiner withdraw the rejection based on 35 USC 102(e).

**Rejection based on 35 USC 103.** Claims 16, 17, and 20 were rejected under 35 USC 103 based on the reasoning that if Han or Zhang did not anticipate the claimed compounds, they rendered them obvious. The applicants respectfully traverse.

At the time of the invention, both the Han and Zhang patents were commonly assigned to the DuPont Pharmaceutical Company. Subsequently, the Bristol-Myers Squibb Company purchased the DuPont Pharmaceutical Company, but at all times the patents were commonly owned and assigned. Because the references qualify as prior art only under 35 USC 102(e) and the priority application for this divisional was filed after November 29, 1999, the references cannot be used as sources of prior art under 35 USC 103(c).

Because Han and Zhang cannot be used as prior art under 35 USC 103(c), the applicants respectfully request the examiner withdraw the rejection based on obviousness.

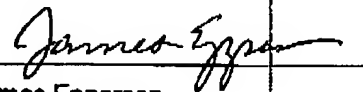
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The applicants believe the application is in condition for allowance and respectfully request favorable reconsideration. If any issues remain, the examiner is respectfully invited to contact the applicants' agent, James Epperson, by phone (203-677-6974), fax (203-677-6900), or e-mail (james.epperson@bms.com).

Respectfully yours,

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